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EXAMINER

PHAN, JOSEPH T

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,388

Applicant(s)

ADAMCZYK ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 1 and 6 objected to because of the following informalities: Grammatical errors are within claims 1 and 6, appropriate words are needed or removed for correctness and clarity. For example in claim 1, line 7, the phrase "in response to notice" and "in response...is to rejoin" is unclear. Examiner recommends "to a notice" and "in response...to rejoin."

Furthermore in claims 1-12, the single capital letters of A, B, and C. needs to be removed as it is improper for a US application. Examiner then recommends rewording the claim where necessary to clarify the corrections.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors which makes the claim unclear and confusing. For example, line 6 state "the call is to be directed" it not known which call as there are several different calls (the initial subscriber call, the return subscriber

call, a VMS call with message, or INE call) and it is not known which device the call is being directed. Line 14 state "the call", usually "the call" is read on the prior call in which this case is the INE call of the same line 14. If it is the INE call then the specification does not enable this method but it is further not known which call is it as there are several different calls.

Examiner recommends applicant to diagram the claim to insure that it is enabled in the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8 rejected under 35 U.S.C. 103(a) as being unpatentable over
Hanson, Patent #5,922,045 in view of Logan et al., Patent #6,199,076.**

Regarding claim 1, Hanson teaches a method for placing a subscriber's communication in a position with respect to a review of messages in a voice messaging program, the method comprising:

- A. in response to an indication from the subscriber's communication to leave the review, creating an identifier to mark the position of the subscriber's communication in the review(210-213 Fig.2A and col.3 line 55-col.4 line 47);
- B. storing the identifier(col.4 lines 47-51);

C. in response to notice indicating the subscriber's communication is to rejoin the review in the voice messaging program, using the identifier to place the subscriber's communication in the position in the review, whereby a subscriber may interrupt the review of messages in the voice messaging program and then return to the position in the review in the voice messaging program (235-237 Fig.2B and col.5 lines 15-65).

Hanson is silent on using the identifier(bookmark) in a voice mail system(program).

Logan teaches using a bookmark(identifier) in a voice mail program.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Hanson's voice messaging program to include a voice mail program as taught by Logan. One would be motivated to do so as Hanson discloses using bookmarks in a variety of different audio systems(programs) to resume where the user left off for later use(col.1 line 66-col.2 line 30 and col.4 lines 52-55) and Logan teaches using bookmarks in a voice mail program for later retrieval and use(col.3 lines 42-56 and col.16 lines 29-45) as using bookmarks in a voicemail system would be more efficient to the user b/c he is able to return to the position where he left off as taught by Hanson and Logan. Furthermore, Hanson discloses that accessing audio services is well-known but creating and using a bookmark(identifier) with it isn't(col.3 lines 51-57) and a voice mail system is a well-known audio service.

Regarding claim 2, Hanson in view of Logan teaches the method of Claim 1, wherein the notice comprises a copy of the identifier; and wherein action C comprises

using the copy of the identifier with the identifier to place the subscriber's communication in the position in the review (Hanson 224-232 Fig.2B)

Regarding claim 3, Hanson in view of Logan teaches the method of Claim 1, wherein action A comprises, in response to the indication from the subscriber's communication to leave the review, providing a message indicating a release of the subscriber's communication (Hanson 210-213 Fig.2A)

Regarding claim 4, Hanson in view of Logan teaches the method of Claim 3, wherein the message comprises a remote operations (RO) parameter including a copy of the identifier (Hanson 224-237 Fig.2B).

Regarding claim 5, Hanson in view of Logan teaches the method of Claim 4, wherein the message comprises a GR-1129 message comprising the RO parameter including the copy of the identifier (Hanson 224-237 Fig.2B).

Regarding claim 6, Hanson teaches a method of enabling the placement of a subscriber's communication in a position in a review of messages in a voice messaging program, the method comprising:

- A. receiving a message indicating a voice message program release, of the subscriber's communication by the voice messaging program, the message including a copy of an identifier marking the position of the subscriber's communication in the review of messages in the voice message program (210-213 Fig.2A);
- B. storing the copy of the identifier(213 Fig.2A); and

C. in response to receiving notice of a release of the subscriber's communication by a network element other than the voice message program, directing the subscriber's communication to be routed to the voice message program including the copy of the identifier (221 and 235-237 Fig.2B).

Hanson is silent on using the identifier(bookmark) in a voice mail system(program).

Logan teaches using a bookmark(identifier) in a voice mail program.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Hanson's voice messaging program to include a voice mail program as taught by Logan. One would be motivated to do so as Hanson discloses using bookmarks in a variety of different audio systems(programs) to resume where the user left off for later use(col.1 line 66-col.2 line 30 and col.4 lines 52-55) and Logan teaches using bookmarks in a voice mail program for later retrieval and use(col.3 lines 42-56 and col.16 lines 29-45) as using bookmarks in a voicemail system would be more efficient to the user b/c he is able to return to the position where he left off as taught by Hanson and Logan. Furthermore, Hanson discloses that accessing audio services is well-known but creating and using a bookmark(identifier) with it isn't(col.3 lines 51-57) and a voice mail system is a well-known audio service.

Regarding claim 7, Hanson in view of Logan teaches the method of Claim 6, wherein the message comprises a remote operations (RO) parameter including the copy of the identifier (Hanson 224-237 Fig.2B).

Regarding claim 8, Hanson in view of Logan teaches the method of Claim 7,
wherein the message comprises a GR-1129 message comprising the RO parameter
including the copy of the identifier(Hanson 224-237 Fig.2B).

Allowable Subject Matter

4. Claim 9-12 would be allowable if rewritten or amended to overcome the
rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

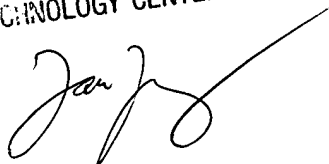
Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Joseph T Phan whose telephone number is 703-305-
3206. The examiner can normally be reached on M-TH 8:30-6:30, in every other
Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for
the organization where this application or proceeding is assigned are 703-872-9314 for
regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is 703-305-
9600.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



JTP
July 31, 2003